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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/768,404	01/30/2004	Sven Schwerin-Wenzel	14413-009001 / 2002P10176	3784
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HOLLAND & KNIGHT LLP				
10 ST. JAMES AVENUE				
BOSTON, MA 02116-3889				
EXAMINER				
STRODER, CARRIE A				
ART UNIT		PAPER NUMBER		
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MAIL DATE		DELIVERY MODE		
05/11/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary**Application No.**

10/768,404

Applicant(s)

SCHWERIN-WENZEL ET AL.

Examiner

CARRIE A. STRODER

Art Unit

3689

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 April 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 January 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/CDC)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

DETAILED ACTION

1. This is in response to the applicant's communication filed on 16 April 2009, wherein:

Claims 1-5 are currently pending; and

Claims 6-23 are cancelled.

Election/Restrictions

1. Applicant's election without traverse of claims 1-5 in the reply filed on 16 April 2009 is acknowledged.

Drawings

2. New corrected drawings in compliance with 37 CFR 1.121(d) are required in this application because several of the drawings are hand-drawn, or have hand-written remarks, and/or are blurry and hard to read. Applicant is advised to employ the services of a competent patent draftsman outside the Office, as the U.S. Patent and Trademark Office no longer prepares new drawings. The corrected drawings are required in reply to the Office action to avoid abandonment of the application. The requirement for corrected drawings will not be held in abeyance.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-5 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

In order for a method to be considered a "process" under §101, a claimed process must either: (1) involve a particular machine, or (2) transform underlying subject matter (such as an article or materials). *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972). If neither of these requirements is met by the claim, the method is not a patent eligible process under §101 and is non-statutory subject matter. With respect to claims 1-5, the claim language does not include the required tie or transformation and thus is directed to nonstatutory subject matter. Although claims 1 and 3 mention "information systems," this term is broad and may include a mere collection of information and does not necessarily implicate either a computer system or another machine.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the

effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. **Claims 1-5 are rejected** under 35 U.S.C. 102(e) as being anticipated by Marpe et al. (US 20020184191).

Referring to claim 1:

Marpe teaches

treating two or more information systems as a single logical information system to execute pre-change due diligence and post-change integration of the enterprise change, the enterprise change being at least one of a merger and acquisition (paragraphs 81 and 94-97; "internet"); and

providing a user interface to allow a user to conduct a merger activity (paragraphs 39 and 94-97).

Further, "to execute pre-change due diligence and post-change integration of the enterprise change, the enterprise change being at least one of a merger and acquisition" and "to allow a user to conduct a merger activity" are statements of intended use. Statements of intended use do not limit the scope of a claim or claim limitation. See MPEP 2106.

Referring to claim 2:

Marpe teaches wherein the user interface is adapted to allow a stakeholder plan and manage the merger activity, the

user interface further adapted to allow a user to access one or more merger resources (paragraphs 39 and 94-97).

Further, "adapted to allow a stakeholder plan and manage the merger activity, the user interface further adapted to allow a user to access one or more merger resources" is a statement of intended use. Statements of intended use do not limit the scope of a claim or claim limitation. See MPEP 2106.

Referring to claim 3:

Marpe teaches
providing a single logical physically distributed information system across one or more information systems of at least two enterprises that are being combined (paragraphs 81 and 94-97; "internet"); and

providing a user interface to access the single logical physically distributed information system, wherein the single logical physically distributed information system executes one or more pre-merger activities, merger activities, and post-merger activities (paragraphs 39, 94-103, and 666-723).

Referring to claim 4:

Marpe teaches wherein the user interface is adapted to at least one of a role of the user and a phase of the merger, wherein the user role comprises an internal expert and an external expert of one of the enterprises, wherein the internal

expert comprises at least one of an executive, an employee, a manager, an investor, and an owner of one of the enterprises, wherein the external expert comprises at least one of a consultant and an auditor (paragraphs 6-7 and 245-246).

Referring to claim 5:

Marpe teaches wherein the role of the user further comprises a stakeholder affected with one or more merger closing consequences, wherein the one or more merger activities comprise an organizational restructuring, a personnel redeployment, a merger project management, a procurement management, a personnel retainment, and an integration of operational services (paragraphs 94-97).

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- a. Stolarz (US 6240421);
- b. Kavounis et al. (US 20020116213);
- c. Hickey (US 20020138570);
- d. Johnson et al. (US 20020152210);
- e. Sanches (US 20030018510);
- f. Marpe et al. (US 6571235);
- g. Maeda (US 20030158768); and
- h. Walsh et al. (US 6810429).

Contact

Any inquiry concerning this communication or earlier communications from the examiner should be directed to CARRIE A. STRODER whose telephone number is (571)270-7119. The examiner can normally be reached on Monday - Thursday 8:00 a.m. - 5:00 p.m. ET.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jan Mooneyham can be reached on (571)272-6805. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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Examiner, Art Unit 3689

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Supervisory Patent Examiner, Art Unit 3689